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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,781	11/13/2001	Brant Candelore	080398.P420	8845

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EXAMINER

PICH, PONNOREAY

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,781

Applicant(s)

CANDELORE, BRANT

Examiner

Ponnoreay Pich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/02, 7/03, 10/03, 3/04, 5/04, 6/04, 5/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-56 have been examined and are pending.

Priority

The examiner recognizes applicant right to an effective filing date of 12/8/2000.

Information Disclosure Statement

The IDS submitted by the applicant have been considered.

Specification

The disclosure is objected to because of the following informalities:

1. Applicant used the terms "FP reader", "stored FP", and "FP logic" on page 13, paragraph 32. Applicant did not define what FP stands for. The examiner assumes it stands for "fingerprint" as fingerprints are discussed in the same paragraph.
2. On page 8, paragraph 66, applicant refers to a PTD 1060 in Figure 10. Item 1060 in Figure 10 is a Display/Input Device not a PTD.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37-38, 41-42, 44-45, 47-48, 51-52, and 54-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (US 5,598,474).

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Claim 37:

Johnson discloses an apparatus comprising:

1. A transaction terminal configured to communicate with a device wherein an output of a first cryptographic process is written from the device to the transaction terminal and the first cryptographic process and a second cryptographic process are used to validate a transaction (col 6, lines 34-57).

Claim 47:

Johnson discloses an apparatus comprising:

1. A transaction terminal configured to communicate with a personal transaction card wherein an output of a first cryptographic process is written from the personal transaction card to the transaction terminal and the first cryptographic process and a second cryptographic process are used to validate a transaction (col 6, lines 34-57).

Claims 38 and 48:

Johnson further discloses wherein the second cryptographic process to be performed by at least one of a transaction terminal, a financial processing system, a transaction privacy clearing house (TPCH), the device, and a vendor (col 6, lines 34-57).

Claims 41 and 51:

Johnson further discloses wherein a comparison of at least one of the output of the first cryptographic process and the input to the first cryptographic process with at least one of an output of the second cryptographic process and an input to the second

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cryptographic process allows a transaction if a result of the comparison is within a predetermined range (col 6, lines 34-57).

Claims 42 and 52:

Johnson further discloses wherein the comparison occurs at the transaction terminal (col 6, lines 34-57).

Claims 44 and 54:

Johnson further discloses comparing at least one of the output of the first cryptographic process and the input to the first cryptographic process with at least one of the output of the second cryptographic process and the input to the second cryptographic process (col 6, lines 34-57).

Johnson does not explicitly disclose wherein the comparison prevents a transaction. However, as Johnson discloses the comparison being done for a validation and security check (col 6, lines 34-57), it is inherent that if the comparison does not indicate a valid match that the transaction would be prevented.

Claims 45 and 55:

Johnson further discloses wherein the comparison occurs at the transaction terminal (col 6, lines 34-57).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 14-23, 27, 32-35, 40, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 5,598,474) in view of Yamaguchi et al (US 6,314,196).

Claim 1:

Johnson discloses a method comprising:

1. Obtaining data from a device for use as an input to a first cryptographic process (col 5, lines 12-22).
2. Creating an output of the first cryptographic process (col 5, lines 12-22 and 52-54).
3. Writing the output from the first cryptographic process to a storage location (col 5, line 55).

Johnson does not disclose wherein the output is valid for a limited period of time. However, Yamaguchi discloses wherein outputs (such as fingerprint data) are only valid for a limited period of time (col 12, lines 23-26 and col 31, lines 47-66). The examiner also notes that even without Yamaguchi's teachings, outputs from a cryptographic process being valid only for a limited amount of time is well known and often employed as it leads to better security for whatever system is using such an output for validation or authorization purposes.

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Johnson also does not explicitly disclose writing the output from the first cryptographic process to a storage location **after the device is received by a user**. However, this limitation is obvious to Johnson because the data for use as an input cannot be obtained from the user until the device, which does the obtaining, is received by the user because the input data disclosed by Johnson is biometric data.

In light of the above, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Johnson's method according to the limitations recited in claim 1. One of ordinary skill would have been motivated to do so as Yamaguchi discloses that the longer the lapse of time between registration of a fingerprint, the lower the matching rate (col 2, lines 4-7) and his teachings would result in improved security in checking a fingerprint (col 12, lines 20-22).

Claim 14:

Claim 14 is substantially similar to claim 1 and is rejected for the same reasons and motivations discussed in claim 1. The difference is that claim 14, discloses a computer readable medium containing executable computer program instructions, which when executed by a data processing system, cause the data processing system to perform a method as recited in claim 1.

Claim 27:

Johnson discloses an apparatus comprising:

1. Security logic used to perform a first cryptographic process wherein an input to the first cryptographic process results in an output of the first cryptographic process (col 5, lines 12-22 and 52-55).
2. A device communicatively coupled to the security logic and configured to write the output of the first cryptographic process to a storage location (col 5, lines 52-55).

Johnson does not disclose wherein the output is valid for a limited period of time. However, Yamaguchi discloses wherein outputs (such as fingerprint data) are only valid for a limited period of time (col 12, lines 23-26 and col 31, lines 47-66). The examiner also notes that even without Yamaguchi's teachings, outputs from a cryptographic process being valid only for a limited amount of time is well known and often employed as it leads to better security for whatever system is using such an output for validation or authorization purposes.

Johnson also does not explicitly disclose writing the output from the first cryptographic process to a storage location **after the device is received by a user**. However, this limitation is obvious to Johnson because the data for use as an input cannot be obtained from the user until the device, which does the obtaining, is received by the user because the input data disclosed by Johnson is biometric data. In light of the above, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Johnson's apparatus according to the limitations recited in claim 27. One of ordinary skill would have been

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motivated to do so as Yamaguchi discloses that the longer the lapse of time between registration of a fingerprint, the lower the matching rate (col 2, lines 4-7) and his teachings would result in improved security in checking a fingerprint (col 12, lines 20-22).

Claims 2, 15, and 32:

Johnson discloses a first cryptographic process (col 5, lines 51- 59). Johnson does not disclose wherein the first cryptographic process **is based on a time stamp**. However, Johnson's cryptographic process is based on fingerprint data (col 5, lines 51-59). Further, Yamaguchi discloses that he has a time stamp associated with fingerprint data (col 30, line 66-col 31, line 4; col 31, lines 47-66; and Fig 21, item 82). In light of this, it would have been obvious to have further modified Johnson's invention according to the limitations recited in claims 2, 15, and 32. One of ordinary skill would have been motivated to do so for the same reason given in claim 1.

Claims 3 and 16:

Johnson further discloses wherein the data is obtained from the user (col 5, lines 12-22 and 51-59).

Claims 4 and 17:

Johnson further discloses wherein the data is entered with at least one of a biometric device, a keypad, and a microphone (col 5, lines 12-22 and 51-59).

Claims 5 and 18:

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Johnson further discloses creating an output of a second cryptographic process, wherein the data is used as input the second cryptographic process (col 5, lines 51-59 and col 6, lines 34-49).

Claims 6, 19, 40, and 50:

Johnson discloses a second cryptographic process (col 5, lines 51-59 and col 6, lines 34-49). Johnson does not disclose wherein the second cryptographic process is **based on a time stamp**. However, Johnson's cryptographic process is based on fingerprint data (col 5, lines 51-59). Further, Yamaguchi discloses that he has a time stamp associated with fingerprint data (col 30, line 66-col 31, line 4; col 31, lines 47-66; and Fig 21, item 82). In light of this, it would have been obvious to have further modified Johnson's invention according to the limitations recited in claims 6, 16, 40, and 50. One of ordinary skill would have been motivated to do so for the same reason given in claim 1.

Claims 7 and 20:

Johnson further discloses wherein the second cryptographic process is performed by at least one of a device, a point of sale (POS) terminal, a transaction privacy clearing house (TPCH), a vendor, and a financial processing system (col 6, lines 34-56).

Claims 8 and 21:

Johnson further discloses comparing at least one of the output of the first cryptographic process and the input to the first cryptographic process with at least one

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of the output of the second cryptographic process and the input to the second cryptographic process (col 6, lines 34-56).

Claims 9 and 22:

Johnson further discloses allowing a transaction based on the comparing (col 6, lines 34-56).

Claims 10 and 23:

Johnson does not explicitly disclose preventing the transaction based on the comparing. However, as Johnson discloses the comparison being done for a validation and security check (col 6, lines 34-56), it is obvious that if the comparison does not indicate a valid match that the transaction would be prevented.

Claim 33:

Johnson further discloses a user interface communicatively coupled with the security logic, wherein the input to the first cryptographic process comprises data entered from the user interface (col 5, lines 12-22 and 52-59).

Claim 34:

Claim 34 recites a limitation substantially similar to claim 4 and is rejected for the same reasons.

Claim 35:

Johnson further discloses wherein the security logic comprises logic that confirms an identification, the identification selected from the group consisting of DNA identification and biometric data (col 5, lines 12-22 and col 6, lines 34-56). Johnson

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also discloses that personal identification number (PIN) was often used for identification purposes in most of today's ID cards (col 1, lines 44-46).

Johnson does not disclose voice identification being one of the groups of selected identification. However, voice identification systems were well known at the time the applicant's invention was made. One of ordinary skill would be motivated to use it as it is a commonly used identification scheme.

Claims 11-12, 24-25, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 5,598,474) in view of Yamaguchi et al (US 6,314,196) and further in view of Gordon et al (US 6,289,323).

Claims 11 and 24:

Johnson and Yamaguchi do not explicitly disclose wherein the comparing occurs without providing an identity of the user. However, Gordon discloses a comparison occurring without providing an identity of the user (col 2, lines 16-24). In light of this, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Johnson and Yamaguchi's combination invention according to the limitation recited in claims 11 and 24. One of ordinary skill would have been motivated to do so as Gordon discloses that his teachings can be used for conducting monetary transactions (col 2, lines 1-4). The examiner also notes that occasionally, a user might want to remain anonymous to some of the parties involved.

Claims 12, 25, and 36:

Johnson and Yamaguchi do not explicitly disclose wherein the device is configured with a limit on transactions to be authorized, the limit being at least one of limiting an amount of money to be spent in a given time period, barring certain users from making certain types of transactions, and barring certain types of transactions. The examiner notes that this limitation is well known in the art at the time the applicant's invention was made, such as with credit card or gift certificate usage wherein the limitation is enforced as a way to make sure a user does not overspend or to control the spending habits of users.

Further, Gordon discloses wherein the device is configured with a limit on transactions to be authorized, the limit being at least one of limiting an amount of money to be spent in a given time period, barring certain users from making certain types of transactions, and barring certain types of transactions (col 1, lines 39-43 and col 3, lines 25-48). In light of this, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Johnson and Yamaguchi's combination invention according to the limitation recited in claims 12, 25, and 36. One of ordinary skill would have been motivated to do so for the same reasons given in claims 11 and 24.

Claims 13, 26, and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 5,598,474) in view of Yamaguchi et al (US 6,314,196) and further in view of Weissman (US 6,353,811) and Waite et al (US 5,594,230).

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Claims 13 and 26:

Johnson further discloses wherein the storage location is selected from the group consisting of a magnetic strip and a personal transaction card (col 5, line 55). Johnson does not explicitly disclose the group also consisting of a magnetic strip emulator and a bar code emulator. However, a magnetic strip emulator and a bar code emulator are well known and commonly used types of storage mediums for identification data.

Further, Weisman discloses a magnetic strip emulator being used to store data (col 3, lines 62-67). Waite discloses a bar code emulator being used to store data (col 4, lines 29-33). In light of this, it would have been obvious to one of ordinary skill in the art to have included a magnetic strip emulator and bar code emulator as one of the choices for the storage location. One of ordinary skill would have been motivated to do so as a magnetic strip emulator and bar code emulator were common form of storage locations. Further, Weisman discloses that a magnetic strip emulator can use used in an electronic wallet (col 3, lines 62-67) and Waite discloses that use of a bar code emulator can allow extensive set of test operations of a bar code reader (col 4, lines 23-28).

Claims 28-31:

Claims 28-31 discloses limitations substantially similar to the ones rejected in claims 13 and 26. As such they are rejected for the same reasons given in claims 13 and 26.

Claims 39 and 49 are rejected under rejected under 35 U.S.C. 103(a) as being unpatentable over by Johnson (US 5,598,474) in view of Reeder (US 6,014,636).

Claims 39 and 49:

Johnson discloses wherein the transaction terminal is a point of sale (POS) terminal (col 6, lines 34-57). Johnson does not explicitly disclose wherein the transaction terminal is selected from the group consisting of a home computer system, a bank automatic teller machine (ATM) terminal, digital television, internet appliance, and personal POS terminal.

However, Reeder discloses a transaction terminal can be a home computer system, a bank automatic teller machine (ATM) terminal, digital television, internet appliance, and personal POS terminal (col 1, lines 5-32 and col 3, lines 5-9). In light of this it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Johnson's invention according to the limitations recited in claims 39 and 49. One of ordinary skill would have been motivated to do so as Reeder discloses that his teachings would allow a customer to not be present at the merchant's location and can instead select merchandise and effectuate payment at home (col 2, lines 31-35).

Claims 43, 46, 53, and 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 5,598,474) in view of Gordon et al (US 6,289,323).

Claims 43, 46, 53, and 56:

Johnson does not explicitly disclose wherein the comparison occurs without providing an identity of the user. However, Gordon discloses a comparison occurring without providing an identity of the user (col 2, lines 16-24). In light of this, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Johnson invention according to the limitation recited in claims 43, 46, 53, and 56. One of ordinary skill would have been motivated to do so as Gordon discloses that his teachings can be used for conducting monetary transactions (col 2, lines 1-4). The examiner also notes that occasionally, a user might want to remain anonymous to some of the parties involved.

Claim 57:

Johnson does not explicitly discloses wherein the device is configured with a limit on transactions to be authorized, the limit being at least one of limiting an amount of money to be spent in a given time period, barring certain users from making certain types of transactions, and barring certain types of transactions. The examiner notes that this limitation is well known in the art at the time the applicant's invention was made, such as with credit card or gift certificate usage wherein the limitation is enforced as a way to make sure a user does not overspend or to control the spending habits of users.

Further, Gordon discloses wherein the device is configured with a limit on transactions to be authorized, the limit being at least one of limiting an amount of money to be spent in a given time period, barring certain users from making certain types of transactions, and barring certain types of transactions (col 1, lines 39-43 and col 3, lines

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25-48). In light of this, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Johnson's invention according to the limitation recited in claim 57. One of ordinary skill would have been motivated to do so for the same reasons given in claims 43, 46, 53, and 56.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 48 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 38. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Conclusion

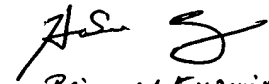
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 8:00am-4:30pm Mon-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PP


Primary Examiner
Art Unit 2135